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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERRIT H. SOEPENBERG, OCTAVIUS J. MORRIS,
LEENDERT T. ROZENDAAL, and JONATHAN R. PIESING

Appeal 2008-5172
Application 09/881,599
Technology Center 2100

Decided: September 21, 2009

Before LEE E. BARRETT, LANCE LEONARD BARRY, and HOWARD
B. BLANKENSHIP, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Patent Examiner rejected claims 1-3, 6-10, 12-16, and 18-25. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

The invention at issue on appeal records digital material that has been broadcasted. (Spec. 1.)

ILLUSTRATIVE CLAIM

1. A transmission system comprising a transmitter and at least one receiver configured to receive signals transmitted therefrom, wherein carousel-forming data file and directory objects are sent in cycles with predetermined groups of file and directory objects being formed into respective modules at the transmitter, with each module being transmitted as a whole, and the receiver being arranged to store, for retrieval upon subsequent playback, received file data and directory objects under a predetermined grouping formulation, wherein the file and directory modules are comprised in discrete data portions carried in an elementary data stream, with said predetermined grouping formulation for storage being at the module level further including an indication for the interval in which they are valid.

PRIOR ART

Ferguson	6,052,555	Apr. 18, 2000
Inoue	6,496,896	Dec. 17, 2002

REJECTIONS

Claims 1-3, 6-10, 12-16, 18-22, 24, and 25 stand rejected under 35 USC 102(e) as anticipated by Inoue.

Claim 23 stands rejected under 35 USC 103(a) as obvious over Inoue and Ferguson.

CLAIM GROUPING

The Appellants argue claims 1-3, 6-10, 12-16, and 18-25 as a group. (Br. 8-11.) Rather than arguing the rejection of claim 23 separately, they rely on their argument for the group. (*Id.* 12-13.) We select claim 1 as the sole claim on which to decide the appeal of the group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The Examiner finds that "Inoue discloses . . . an 'interval' as interpreted as space, gap or distance in terms of first track, last track, clusters, sector use, start address and end address for a sector." (Ans. 12.) The Appellants argue that "Inoue fails to describe including 'an indication for the interval in which

they [the stored data] are valid,' as is described in the claims." (Br. 9.)
Therefore, the issue before us is whether the Appellants have shown error in the Examiner's finding that Inoue discloses storing an indication for the interval in which stored data are valid.

LAW

"[A]nticipation is a question of fact." *In re Hyatt*, 211 F.3d 1367, 1371-72 (Fed. Cir. 2000) (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)).
"[A]nticipation of a claim under § 102 can be found . . . if the prior art reference discloses every element of the claim" *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)).
"Silence implies assent." *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 572 (1985)).

FINDINGS OF FACT (FFs)

1. The "Appellant[s] ha[ve] failed to provide an explicit and deliberate definition of the word 'interval' which is recited in claim 1" (Answer 10) and claim 22.

2. "Interval is defined as . . . a space between two things, a gap, distance The above definition shows that essentially 'interval' denotes space or distance." (*Id.* (internal footnote omitted)).

3. Inoue discloses that "at predetermined byte positions, data of a maker code, a model code, a track number (First TNO) of the first track, a track number (LAST TNO) of the last track, a sector use situation (Used sectors), a disc serial number, a disc ID and so forth are recorded." (Col. 32, ll. 54-58.)

4. The reference includes the following additional disclosure.

[P]ointers P-TNO1 to P-TNO255 indicate tracks of tunes or the like recorded on the magnet-optical disc 90 by a user. For example, the pointer P-TNO1 designates a part table which indicates a part or a top one, with respect to time, of a plurality of parts in which data of the first track are recorded. For example, if a tune of a first track or a first program is recorded without being divided, that is, recorded in one part, on the disc, the recording area of the first track is designated with start and end addresses in a part table indicated by the pointer P-TNO1. (Col. 34, ll. 20-30.)

ANALYSIS

The Appellants provide no definition of the word "interval." (FF 1.) It is uncontested that an "interval" denotes space or distance. (FF 2.) Therefore, the Examiner concludes that "[o]ne of ordinary skill in the art would recognize that 'interval' when used in relation to the claimed 'predetermined grouping formulation for storage' is referring to the space, distance or size of the storage required to store the claimed 'data portions carried in an elementary stream.'" (Answer 10.) The Appellants do not contest, and we accept, the Examiner's claim interpretation.

Inoue teaches storing indications of the track numbers of a first track and last track where data are stored along with an indication of a sector used to store the data. (FF 3.) The reference also teaches storing indicators of the parts of a disc on which tunes are recorded. (FF 4.) In view of these teachings, we agree with the Examiner's finding that Inoue discloses "an 'interval' as interpreted as space, gap or distance in terms of first track, last track, clusters, sector use, start address and end address for a sector." (Ans. 12.) Although the Appellants argue that "Inoue is totally silent as to providing an indicator when the materials A1, A2, B1, and/or B2 are valid" (Br. 10), they do not contest the claim interpretation or the teachings of the reference mentioned previously.

Furthermore, "our reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art." *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (citing *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004)), *aff'd*, 191 Fed. Appx. 959 (Fed. Cir. 2006). "[W]hen descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability." *Mathias*, 84 USPQ2d at 1279 (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)).

Here, we view the phrase "an indication for the interval in which they are valid" as nonfunctional descriptive material. Because no use of the indications is claimed, and no action is performed in response to the storing thereof, the data representing the indication lack a functional relation to the

claimed transmission system. Therefore, the phrase is not entitled to patentable weight.

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have shown no error in the Examiner's finding that Inoue discloses storing an indication for the interval in which stored data are valid.

DECISION

We affirm the rejections of claims 1-3, 6-10, 12-16, and 18-25.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED

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